



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/002,181	12/05/2001	Jochem Sauer	270/098	6324

21890 7590 10/06/2003

PROSKAUER ROSE LLP
PATENT DEPARTMENT
1585 BROADWAY
NEW YORK, NY 10036-8299

EXAMINER

HARAN, JOHN T

ART UNIT	PAPER NUMBER
----------	--------------

1733

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/002,181

Applicant(s)

SAUER, JOCHEM

Examiner

John T. Haran

Art Unit

1733

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 08/860,762
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 12/5/01 has been considered by the examiner.

Specification

2. The disclosure is objected to because of the following informalities: The disclosure should indicate that the parent application 08/860,762 is now U.S. Patent 6,350,343.

Appropriate correction is required.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 9-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 6,350,343. Although the conflicting claims are not identical, they are not patentably

Art Unit: 1733

distinct from each other because both claim 9 of the application and claim 1 of the patent claim a process for surface pretreatment comprising providing a clean metal surface which is aluminum or an aluminum alloy, applying a composition comprising an organosilane to the clean metal surface to form a coated surface and exposing the coated surface to laser which produces an elevated temperature on the coated surface. While claim 1 of the patent claims a more specific composition it still includes an organosilane and therefore the specific composition of claim 1 of the patent is encompassed by the broad composition of claim 9 of the application requiring the composition to comprise an organosilane. Claim 9 of the present application encompasses and reads on claim 1 of the patent and therefore there is obviousness type double patenting. It is noted that the patent is the parent application of the present application, however since claims 9-15 were not originally presented in the patented application an obviousness type double patenting rejection is proper because if the claims had been originally presented in the parent application they would not have been restricted and would have been prosecuted in the parent application.

The limitations of claim 11 and 12 of the present application are taught in claim 1 of the patent.

The limitation of claim 10 of the present application is taught in claim 2 of the patent.

The limitation of claim 13 of the present application is taught in claim 3 of the patent.

The limitation of claim 14 of the present application is taught in claim 4 of the patent.

The limitation of claim 15 of the present application is not claimed in any of the claims of the patent however it would have been obvious in claim 2 of the patent that R is one of the specified groups because the patent teaches that R is one of the specified groups (Column 2, lines 29-31). It would have been obvious to one of ordinary skill in the art at the time the invention was made for R to be one of the claimed groups in claim 2 of the patent since the patent teaches R being one of the claimed groups.

The limitation of claims 16-18 of the present application is not claimed in any of the claims of the patent however it would have been obvious in claim 2 of the patent that R1 is one of the specified groups because the patent teaches that R1 is one of the specified groups (Column 2, lines 32-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made for R1 to be one of the claimed groups in claim 2 of the patent since the patent teaches R1 being one of the claimed groups. Furthermore claim 5 of the patent teaches bonding the lased coated metal surface to another surface with an adhesive and it would have been obvious to one of ordinary skill in the art at the time the invention was made for the organosilane to comprise the claimed formula and groups taught in the patent.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Sauer (U.S. Patent 6,488,805) is cited of interest for teaching applying a composition comprising organosilane to a metal surface other than a clean aluminum or aluminum alloy surface and exposing the coated surface to laser (See Abstract).

Hatton et al (U.S. Patent 5,451,345) is cited of interest for teaching applying an organosilane compound with the same claimed formula to aluminum for cleaning and priming it and subsequently exposing the coated aluminum with actinic irradiation (Column 1, lines 19-55). There is no suggestion of providing a cleaned aluminum surface (since the compound is for cleaning) and there is no suggestion of exposing the coated surface to a laser.

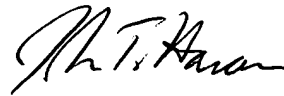
Volkman et al (U.S. Patent 4,861,407) is cited of interest for teaching exposing a cleaned aluminum surface to laser to enhance its adhesion, however there is no suggestion of providing a composition comprising an organosilane to the aluminum surface prior to the exposure to the laser (See Abstract).

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John T. Haran** whose telephone number is **(703) 305-0052**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael W. Ball can be reached on (703) 308-2058. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Art Unit: 1733

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read "John T. Haran". The signature is fluid and cursive, with the first letters of the first and last names being capitalized and prominent.

John T. Haran
Examiner
Art Unit 1733